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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,894	11/07/2005	Jordi Tormo i Blasco	5000-0135PUS1	2720

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EXAMINER	
JARRELL, NOBLE E	
ART UNIT	**PAPER NUMBER**
1624	

NOTIFICATION DATE	DELIVERY MODE
07/17/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/555,894	TORMO I BLASCO ET AL.	
	Examiner	Art Unit	
	Noble Jarrell	1609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *4,6-10 and 12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5 and 11* is/are rejected.

7)☒ Claim(s) *1* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/07/2005 and 4/26/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group II in the reply filed on 6/4/2007 is acknowledged. The traversal is on the ground(s) that the office does not correctly assert that compounds of formula I do not represent a special technical feature over the prior art. This is not found persuasive because prior art does exist for these compounds, and is discussed under the 103 rejection. Applicants also contend that there is no serious search burden. However, this argument is unpersuasive because different core structure searches are required when Y is C or N. When Y is C, the ring is pyrazole (withstanding the oxo group), and when Y is N, the ring is 1,2,4-triazole. Applicants also contend that compositions of the different subjects are overlapping subject material. However, after analysis of variable Y in claim 1, the groups are distinguishable because the ring is either pyrazole (Y is C) or 1,2,4-triazole (Y is N) (ignoring the oxo group on the 5-position). Applicants also contend that rejoinder is a possibility for groups III and VI. Rejoinder only applies where the product is novel. The product is not novel in this case. Applicants also contend that groups V-VI should also be examined. This argument is unpersuasive because groups V-VI do not have pyrazole or 1,2,4-triazole ring attached to the pyrimidine ring. Since applicants elected the ring instead of the chain, groups V-VI will not examined concurrently with group II.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

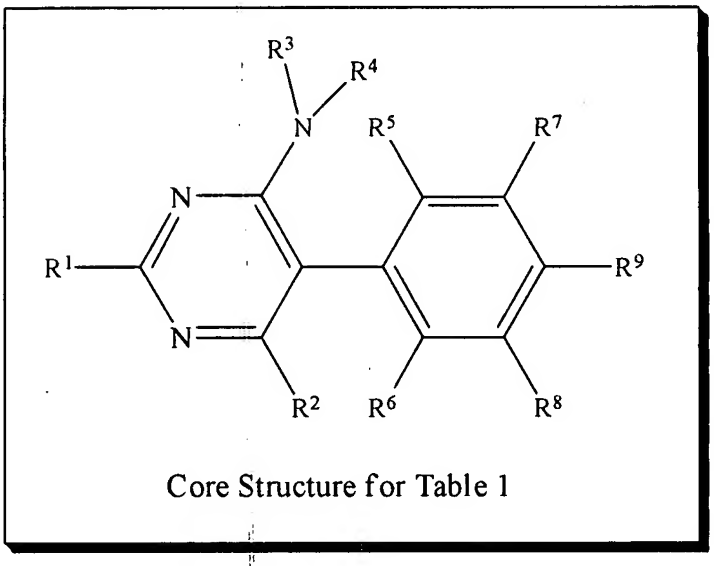
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grote et al. (WO 02/74753, published 26 September 2002, Reference BB of April 26, 2007 IDS). Grote et al. teach structures I-1 and I-29 in table 1 (page 36). The core structure for table I is shown below.



Core Structure for Table 1

The following table shows the groups for compounds I-1 and I-29.

Compound	R^1	R^2	R^3	R^4	R^5	R^6	R^7	R^8	R^9
I-1	Pyrazolyl-1	Cl	Isopropyl	H	Cl	F	H	H	H
I-29	1,2,4-triazolyl	Cl	Isopropyl	H	Cl	F	H	H	H

These compounds render compounds of claim 1-3 and 5 obvious, except for the fact that they do not have an oxo group attached at the 5-position of the pyrazole and the triazole. Grote et al. do not

explicitly prepare a compound of formula I where an oxo group is attached to the 5-postion of the pyrazole or 1,2,4-triazole ring. However, on page 3, it states that variable R^a, which is a substituent on the pyrazole or triazole ring, can be oxo, among other groups. The elected species, example 3, is held unobvious over compound I-2 of table 1, which only differs from compound I-1 in that R^3 is *(S)*-$CH(CH_3)CF_3$ and R^5 and R^9 are F. Claim 11 is obvious over Grote et al. because on page 46, example 1, the reference discloses a composition consisting of 10 % of the active compound, 63 % cyclohexanone, and 27% of an emulsifier, for the purposes of treating leaves of an *Alternaria solani*. Based in this logic, Grote et al. are obvious over instant claims 1-3, 5, and 11.

The motivation for attaching variable R^a in Grote et al. (page 1, lines 25-34, of the specification) to variable R^1 in Grote et al. (page 1, lines 17-22, of the specification) is based on MPEP 2144.08, which cites *In Stratoflex, Inc. v. Aeroquip Corp.*, 713 F. 2d 1530. In this case, the court noted, "the question under 35 U.S.C. 103 is not whether the differences [between the claimed invention and the prior art] would have been obvious" but "whether the claimed invention as a whole would have been obvious." One of ordinary skill in the art would be motivated to make any of the species that are taught in the genus of the reference with a reasonable expectation of success of obtaining compounds with analogous properties. Thus, claims 1-3, 5, 11 and the elected species are unobvious over Grote et al.

Double Patenting

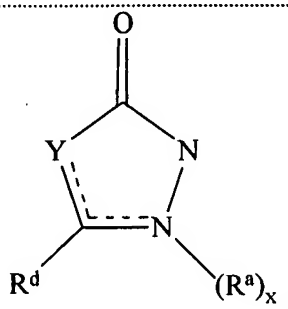
5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or

claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 5, and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7 of U.S. Patent No. 7,153,860 ('860). Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject material as well as species that could be embraced by both sets of claims. Instant claims 1-3 and 5 overlap with claims 1-4 of '860. The following table shows example of overlap between the instant claims and the claims of '860.

Instant claims 1-3, 5	'860 claims 1-4
 R^4 is Y= C or N	R^1 is pyrazole, 1,2,4-triazole, 1,23-triazole, etc.
R^a is hydrogen, alkyl, cycloalkyl	R^a is halogen, hydroxyl, cyano, oxo, nitro amino, mercapto, etc.
R^1, R^2 are C_1-C_6-alkyl	R_3, R_4 are hydrogen, alkyl
L_n where L is halogen, cyano, alkyl and n is 1-5	R^5: halogen, R^6: hydrogen, halogen, alkyl; R^7, R^8, R^9: hydrogen, halogen, alkyl

Variable R^4 of the instant claims is equivalent to the combined groups R^1 and R^a of '860 because R^a is a substituent of ring R^1 in the '860 claims. It is important to note an oxo group is one possibility for

variable R^a in '860, and therefore a case for obvious-type double patenting is made between the instant claims and '860. In addition, there are 2 more sets of equivalencies: R^1 and R^2 of the instant claims are equivalent to R_3 and R_4 of '860, and L_n of the instant claims is equivalent to variables R^5 through R^9 of '860. Two examples of species that can be embraced by both sets of claims are species of tables 1 and 11 of '860 (column 12, lines 24-40 and column 13, lines 25-40). When variables R^3 and R^4 are both ethyl (as in entry A-3 of table A (column 16, line 30), this species is embraced by both sets of claims. Claim 11 of the instant application is equivalent to claim 7 of the '860 patent because both claims are for compositions suitable for controlling fungi, comprising a solid or liquid carrier and a compound of formula I. Thus, instant claims 1-3, 5, and 11 have a problem of obvious-type double patenting with the '860 claims 1-4 and 7.

Claim Objections

7. Claim 1 is objected to because it contains non-elected subject matter.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on Monday-Friday from 7:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJ

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